

REMARKS

Claims 3-24, 34-36 and 59-65 remain for prosecution in the present application.

Claim Rejections - 35 USC 112

All claims have been rejected as allegedly failing to comply with the written description requirement. However, it is noted that 35 USC 112, first paragraph requires that the specification contain a written description of the invention, and not that the claims contain a written description of the invention. The specification clearly describes how the disk is loosely retained parallel to but separate from the base wall of the closure shell. The disk 46 is shown being loosely retained within the closure shell in FIGS. 1-3. In the same way, the disk 72 is loosely retained within the closure shell in FIGS. 7-9. See also page 3, lines 1-2; page 8, line 1+; and especially page 9, lines 6-9 of the application text. There is no requirement that the claims repeat or contain every structural detail described in the specification and/or illustrated in the drawings.

The claims are rejected as allegedly failing to comply with the enablement requirement. It is noted, however, that 35 USC 112, first paragraph requires that the specification disclose the invention so as to enable persons skilled in the art to make and use the same. There is no requirement that the claims recite each and every structural detail of the subject matter enabled by the specification. More specifically, there is no requirement that the claims must recite details of structure by means of which the disk is loosely retained parallel to but separate from the base wall of the closure shell.

The claims are rejected under 35 USC 112, second paragraph as allegedly failing particularly to point out and distinctly to claim the subject matter which applicants regard as the invention. However, applicants do not regard specific structural details by means of which the disk is loosely retained parallel to but separate from the base wall of the closure shell as being necessary to claiming of the invention. The general feature of "loose retention" of the sealing member within the closure shell is not new in and of itself. For example, the packing member 9 in Takano 5,984,124 cited by the Examiner is loosely retained within the closure shell 6. This appears also to be the case with the liner disk 30 in McBride 6,761,275 and the fluid seal 3 in Racine 6,581,793.

Thus, the claim rejections under 35 USC 112 clearly should be withdrawn.

Claim Rejections - Double Patenting

A Terminal Disclaimer to obviate the double patenting rejection over U.S. 6,874,647 is enclosed with this submission to remove this basis for rejection.

Claim Rejections - Prior Art

Takano 5,984,124 combined with JP 2-258325

A number of the application claims, including particularly independent claims 16, 38 and 59-60, are rejected over Takano 5,984,124 combined with JP 02-258325. Reconsideration is respectfully requested.

Takano discloses a pilfer-proof closure that has a packing 9 disposed within a cap 6. The top wall 1 of the cap 6 is imperforate. The top surface of the packing 9 has grooves 13 and gaps N that provide an "air reservoir" 12 between the packing 9 and the top wall 1 of the cap 6. This "air reservoir" is a primary feature of the Takano disclosure,

being discussed in detail starting at column 2, lines 26-30; column 3, lines 40-66; and column 5, line 52 to column 6, line 4, for example. The disclosed purpose of this air reservoir is to permit rotation of the cap 6 while the packing 9 remains in place, at least until the pilfer-proof band 8 is severed from the cap. The packing 9 has a sealing member 11 that is received within the mouth of the container neck finish, thus forming a plug (column 5, lines 49-52 and column 6, lines 52-54). It is not apparent, even with the impermissible benefit of hindsight, why a resilient sealing liner would be "obvious" or even desired in such a construction, even if the secondary JP reference suggested such a liner.

The Japanese patent document cited as the secondary reference is directed to a vial from which product is removed by means of a syringe needle, and has nothing whatever to do with the subject matter disclosed and claimed in the present application. In FIG. 4 of this reference, for example, a rubber stopper 24 is retained by a shell 26 over the opening of a container 21. There is no disclosure or suggestion in the information provided that the shell 26 and/or the rubber stopper 24 is removable from the container, and indeed the rubber stopper and the annular affixment structure typically are not readily removable in packages of this type. This is in sharp contrast to the present invention, as well as the primary Takano reference, in which internal threads or other means are provided on the closure skirt for application and removal of the closure to and from a container neck finish.

Continuing discussion of the Japanese reference, a film 25 of "super-high molecular weight" polycarbonate is secured by thermoforming to the underside of the rubber stopper 24. The purpose of the super-high molecular weight polycarbonate film is to prevent particles or "cuttings," which might separate from the rubber stopper when a

syringe needle is inserted through the stopper, from falling into the product within the package. The rubber stopper 24 is formed and the film 25 simultaneously is attached to the rubber stopper by a thermoforming operation illustrated in FIG. 2, in which the rubber and the polycarbonate film are preheated to the vulcanization temperature of the rubber, and are thermoformed so that the stopper assumes the desired geometry and the film simultaneously is bonded to the undersurface of the rubber stopper. The Examiner refers to the polycarbonate film 25 (or 35 in FIG. 5) as a "liner." However, there is no suggestion whatsoever in the translated abstract materials of the Japanese reference that the polycarbonate film functions as a "liner," as that term is understood in the art, by sealing against an opposing surface of the container neck finish. The translated abstract materials indicate only that the overall package is "sealed," but do not teach or suggest that the super-high molecular weight polycarbonate film performs any sealing function. Construction of the film of "super-high molecular weight" polycarbonate would make the film anything but "resilient" as that term is understood in the art.

In summary, the Japanese reference discloses a completely different type of container and package for a completely different purpose as compared with the subject matter of the present application, and for that matter the subject matter of the primary Takano reference. It is respectfully submitted, first, that the subject matter of the Japanese reference is so different from the subject matter of the primary reference, and different from the subject matter of the present invention, that the Japanese reference is not combinable with the primary reference to suggest the present invention or otherwise. Second, inasmuch as the polycarbonate film disclosed in the Japanese reference is anything but "resilient," as compared with each independent claim of the present application that

specifically recites "a resilient liner," it is submitted that the proposed combination of the Japanese reference with the primary reference does not teach or suggest the present invention in any event.

Takano 5,984,124 in view of McBride 6,761,275

A number of the application claims, including particularly independent claims 16, 38 and 59-60, have been rejected over Takano combined with McBride 6,761,275. Reconsideration is respectfully requested.

The Takano reference is discussed above. The packing 9 has a sealing member 11 that is received within the mouth of the container neck finish forming a plug (column 5, lines 49-52 and column 6, lines 52-54). It is not apparent, even with the impermissible benefit of hindsight, why a resilient liner would be "obvious" or even desirable in such a construction.

The McBride reference discloses a two-piece closure that includes an inwardly domed liner disk 30 (FIGS. 1 and 2) with a seal layer 40 of resilient polymer material applied to the bottom surface and the annular sidewall of the dome. The domed portion 35 of the liner disk 30 flexes outwardly under pressure P (FIG. 2) to urge the annular seal layer 44 into sealing engagement with the inside edge of the container neck finish. Although the McBride reference unquestionably discloses a resilient liner molded onto the disk 30, there is no basis in either this reference or the Takano reference for combining these two references as suggested by the Examiner. In the seal structure disclosed in the primary Takano reference, there is no need for a resilient liner layer, so the implementation of McBride into the Takano reference can be and has been made only

with the impermissible benefit of hindsight using the present application claims for combining and interpreting the references.

[I]n order to meet the terms of the claims on appeal, the elements of the [prior art] device would have to be arranged in a manner different from that disclosed by [the art]. The elements of the reference would also be required to coact differently from the way they coact in the arrangement disclosed by the reference. The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide motivation or reason for the worker in the art, without the benefit of applicant's specification, to make the necessary changes in the reference device.

Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (POBA 1984). See also *Fromsom v. Advanced Offset Plate, Inc.*, 755 F.2d 1549, 225 USPQ 26 (CAFC 1985); *In re Sernaker*, 702 F.2d 989, 217 USPQ 1 (CAFC 1983) and *Ex parte Stauber*, 208 USPQ 945, 946 (POBA 1980).

Simply stated:

It is wrong to use the [application] as a guide through the maze of prior art references, Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

Orthopaedic Equipment Co., Inc. v. U.S., 702 F.2d 1005, 217 U.S.P.Q. 193, 199 (Fed. Cir. 1983). See also *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1942) ("It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art." 23 U.S.P.Q.2d at 1784); *In re Pavlecka*, 138 U.S.P.Q. 152 (CCPA 1953); *Ex parte Garrett*, *supra* .

Racine 6,881,793 in view of McBride 6,761,275

A number of application claims, including particularly independent claims 61-63, have been rejected over Racine 6,881,793 combined with McBride 6,761,275. Reconsideration is respectfully requested.

The Racine reference discloses a closure that includes a cap or shell 2 and an internal disk-shaped fluid seal 3. The fluid seal 3 itself is "made of plastics material capable of being elastically deformed" (column 2, lines 20-21), as clearly shown by comparing FIG. 4 with FIG. 5 in which the closure is assembled to a container neck finish. Inasmuch as the disk-shaped seal itself is of resilient liner-type material, there is no motivation or reason for persons of ordinary skill in the art to provide an additional resilient liner molded onto the disk as expressly required in all independent claims 61, 62 and 63, in view of McBride or otherwise. It further is noted that all of these claims recite the annular rib 78 illustrated in application FIG. 8, for example. The whole point of the McBride disclosure is to provide the seal layer 40 around the inside edge of the container neck finish to form a seal when the domed liner disk 30 is subjected to internal pressure. There is no disclosure or suggestion in either Racine or McBride of providing an annular rib around the radially outer edge of the disk base and/or molding a seal liner onto the disk in such a way that the annular rib underlies the liner for engaging the liner against a radially outer edge of the container neck finish when the closure is secured to the container neck finish.

Each independent claim 16, 38 and 59-63 of the present application expressly recites a plastic disk retained within the closure shell and a "resilient liner" molded onto the disk for sealing engagement with the container finish. See, for example,

claim 16, lines 5 and 10-12; claim 38, lines 7 and 12-14; claim 59, lines 4-6; claim 60, lines 2-5; claim 61, lines 4-6; claim 62, lines 5 and 9-11; and claim 63, lines 7 and 11-13. The independent and dependent claims of the present application recite other distinguishing features, but it is respectfully submitted that these "resilient liner" recitations alone are sufficient to demonstrate patentability over the cited references for reasons discussed in detail above.

It therefore is believed and respectfully submitted that all claims 3-24, 34-46 and 59-65 remaining in the application are allowable at this time, and favorable action is respectfully solicited.

Please charge any fees associated with this submission to Account No. 15-0875 (Owens-Illinois).

Respectfully submitted,

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